

Appl. No. : 10/791,353
Filed : March 2, 2004

REMARKS

Claim 33 Was Previously Corrected

The Examiner objected to Claim 33 based upon improper dependency. Applicant notes that Claim 33 was amended to depend from Claim 32, as originally intended, in the Preliminary Amendment filed on March 2, 2004. Accordingly, Applicant requests that the objection be withdrawn.

Claim 8 Has Been Broadened

The Examiner rejected Claim 8 under 35 U.S.C. § 112, second paragraph. The Examiner determined that a "push-button type switch" was not sufficiently definite. While one of ordinary skill in the art would understand the meaning of a "push-button type switch," Applicant has broadened the term to "switch." Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1, 9-13, 21-23, 26-28 and 31 Are Patentable Over The Applied Combination

Claims 1, 9-13, 21-23, 26-28 and 31 have been rejected as unpatentable over Izumi (United States Patent No. 6,269,899) in view of Nakamura (United States Patent Application Publication No. 2002/0070066A1). Applicant submits the claims are allowable over the applied combination.

Adapted To

The Examiner noted on page 4 of the Office Action that "the word 'adapted' is not a positive limitation but only requires the ability to so perform." The Examiner continued that "Izumi and Nakamura meet all the functional language limitations in the broadest sense."

The language of independent Claim 1 recites:

"a switching system adapted to allow an operator to select among only the following combinations of modes for the front and rear differentials: front disabled and rear unlocked; front disabled and rear locked; front unlocked and rear unlocked; front unlocked and rear locked; and front locked and rear locked."

The language of independent Claim 9 recites:

Appl. No. : 10/791,353
Filed : March 2, 2004

"a switching system adapted to allow an operator to independently select a desired operational mode for each of the front differential mechanism and the rear differential mechanism."

The language of independent Claim 31 recites:

"the front differential mechanism being adapted for operation in an unlocked mode, a locked mode or a disabled mode...the rear differential mechanism being adapted for operation in an unlocked mode, a locked mode or a disabled mode."

It is axiomatic that all limitations in a claim must be considered in applying any statutory provision, including 35 U.S.C. § 103. The above-quoted language of each of these claims contains "adapted to" limitations. Each of these limitations constitutes functional language which defines the claimed switching system and the claimed front and rear differential mechanisms in terms of how they function. There is nothing inherently wrong with the use of functional limitations. See *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA1971).

Even if the Examiner's construction of "adapted to" is proper, as discussed below, neither Izumi nor Nakamura is constructed in a manner that allows the structures disclosed in those references to be capable of performing the recited functions. Thus, even under an extremely broad reading of the limitations at issue, the claimed subject matter would not have been obvious.

In the event the Examiner disagrees with the arguments set forth herein, Applicant is willing to consider any amendments to these limitations that will, in the Examiner's mind, transform these limitations into positive limitations and place the present application in condition for allowance. To reiterate, Applicant considers the "adapted to" limitations to be positive limitations on the claimed subject matter.

Rear Differential Mechanism

Claims 1, 13 and 31 each recite "a rear differential mechanism." Neither of the two applied references discloses a rear differential mechanism. The balance of the rejected claims depend, directly or indirectly, from one of these claims.

As an initial matter, while Izumi discloses a front differential at Col. 3, lines 34-43, Izumi fails to disclose or suggest that the front differential is a lockable differential. With respect to a rear differential, Izumi discloses at Col. 3, lines 44-45: "In the embodiment illustrated, there is

Appl. No. : 10/791,353
Filed : March 2, 2004

but a single rear axle 52 to which both of the rear wheels 48 are mounted.” While Izumi states at Col. 3, lines 60-61, “a rear differential or gear box 82 is supported by the axle 52 and a rear trailing arm 86,” the structure disclosed by Izumi clearly cannot feature both a single axle and a differential because a differential would require a pair of half shafts rather than a single axle. In the event one construed this language to suggest a rear differential, Izumi did not disclose or teach a lockable rear differential.

Similarly, Nakamura, at the end of paragraph 0024, discloses: “The rear shaft is connected to a single rear axle that drives both rear wheels 14.” While Nakamura states “Other arrangements also are possible,” Nakamura did not disclose or teach a rear differential mechanism. Moreover, Nakamura did not disclose or teach a lockable rear differential.

As discussed directly above, neither reference disclosed or taught a lockable rear differential mechanism, as recited by Claims 1, 13 and 31. Thus, neither reference disclosed or taught an arrangement in which the front and the rear differentials could be locked or unlocked in the combinations recited by Claim 1. For instance, neither reference taught a configuration in which the front differential was disabled while the rear differential was locked nor did either reference teach a configuration in which the front differential was unlocked while the rear differential was locked. Furthermore, neither reference disclosed or taught an arrangement in which the operational mode of each of the front and rear differential could be independently selected as recited by Claim 13.

Because neither reference disclosed or taught the limitations discussed directly above, the combination of the two references cannot render Claim 1, Claim 13 or Claim 31 unpatentable. Reconsideration and withdrawal of the rejections of Claims 1, 13 and 31 are respectfully requested. Moreover, the balance of the rejected claims are patentable both for the reasons set forth above and, in some cases, because they recite further patentable distinctions. For instance, Claim 21 recites several limitations relating to the rear differential mechanism and the related switching device while Claim 22 recites a lever moveable between two positions corresponding to the unlocked and locked modes of the rear differential. Reconsideration and allowance of Claims 9-12, 21-23 and 26-28 are also respectfully requested.

Appl. No. : 10/791,353
Filed : March 2, 2004

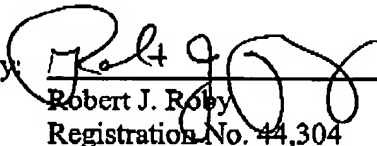
CONCLUSION

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. If any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2-16-2005

By: 
Robert J. Roby
Registration No. 44,304
Attorney of Record
Customer No. 20,995
(949) 760-0404

G:\DOCS\YAMAHA\FY51035US1AAM3.DOC
021605